



Paper No. 6

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COPY MAILED

JUN 13 2002

OFFICE OF PETITIONS

In re Application of	:
Schiller et al.	: DECISION DISMISSING
Application No. 10/006,759	: PETITION
Filed: 10 December, 2001	:
Attorney Docket No. D6350B	:

This is a decision on the petition filed under 37 CFR 1.133 which is treated as a petition requesting waiver of the rules in that an application filed by first class mail using Certificate of Mailing procedures be accorded a filing date of the asserted date of deposit with the USPS, which was 30 November, 2001, rather than the actual date of receipt in the USPTO, which was 10 December, 2001.

The petition is dismissed.

Petitioners assert that the above-identified application was deposited in first-class mail to the Commissioner of Patents, U.S. Patent and Trademark Office, P.O. Box 2327, BOX PATENT APPLICATION, Arlington, VA 22202, on 30 November, 2001. A review of Office records reveals that the application papers were received on, and accorded a filing date of, 10 December, 2001.

Petitioners request that the application be accorded a filing date of 30 November, 2001, the asserted date of deposit with the USPS. In support, petitioners have provided an affidavit by Colleen M. Werner, an employee of petitioners' counsel, stating, to wit, that she spoke to an employee of the USPTO on either 20 or 30 November, 2001, and was informed of the following:

...

2. I placed a telephone call to the United States Patent Office either on November 20th or November 30th to inquire about the Notification Related to United States Postal Interruption issued by the Office of Patent Legal Administration which I had

read but had found confusing. I do not have the name of the person with whom I spoke. Nor do I remember if this conversation occurred immediately or if I left a message and received a return phone call.

3. I asked whomever I spoke with to explain to me how to use the temporary P.O. Box in Arlington, Virginia assigned for correspondence filed under 37 CFR 1.10. I was told that if this address together with the Box the correspondence was to be directed, i.e. Box Patent Application, was placed on a Certificate of Mailing, the attached correspondence would be received as though mailed according to 37 CFR 1.10. I further inquired how this was to be mailed and was informed that it could be mailed via the U.S. Postal Service First Class Mail since express mail was not being accepted.

4. I acted in good faith on this information and I believed that this procedure would accord the filing date as that date on the Certificate of Mailing. I deposited the documents identified on the enclosed return postcard with the U.S. Postal Service as First Class Mail on November 30, 2001 to: The Honorable Commissioner of Patents, U.S. Patent and Trademark Office, P.O. Box 2327, Box Patent Application, Arlington, VA 22201.

...

Petitioners request that the application be accorded a filing date of 30 November, 2001, rather than the currently accorded filing date of 10 December, 2001.

At the outset, petitioners are reminded that Certificate of Mailing Procedures do not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date.

The guidance set forth in the above-mentioned Official Gazette notice and posted on the Internet set on 20 November, 2001, is reproduced below, in pertinent part.

¹37 CFR 1.8(a)(2)(I)(A).

²See, United States Postal Service Interruption and Emergency, 1251 Off. Gaz. Pat. Office 55 (October 9, 2001).

UNITED STATES POST SERVICE INTERRUPTIONS RELATING TO
EXPRESS MAIL SERVICE

Where the USPS refuses to accept the deposit of mail for delivery by express mail.

In some cases, due to the recent emergency, certain post offices are refusing to accept the deposit of mail for delivery by Express Mail service. The USPTO is also designating this interruption in the Express Mail service of the USPS as a postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 CFR 1.6(e). In addition, if a party attempts to deposit correspondence for delivery to the USPTO with the USPS by Express Mail under 37 CFR 1.10 ("Express Mail Post Office to Addressee") and the USPS refuses to accept such correspondence, the party is advised to take the following action: mail the correspondence to the USPTO by registered or first class mail with a statement by the person who originally attempted to deposit the correspondence with the USPS by Express Mail. The statement must indicate the date on which the person attempted to deposit the correspondence with the USPS and that the USPS refused to accept the correspondence. The statement must be signed in accordance with 37 CFR 10.18. The correspondence should be mailed as set out in 37 CFR 1.1(a) and include the special box designation: BOX FILING DATE.

Where mail is put into an Express Mail "Drop Box" and given an incorrect "date in".

In some cases a person may use an Express Mail "drop box" without realizing that the local post office is not accepting Express Mail. In that situation, the provisions of 37 CFR 1.10(d) may apply. Usually 37 CFR 1.10(d) is invoked where correspondence is placed in an Express Mail "drop box" prior to the last pick up that is scheduled for the drop box for that day, but the USPS enters an incorrect "date-in" on the Express Mail mailing label, usually the next day's date. To invoke 37 CFR 1.10(d), however, a petition must be corroborated either by evidence from the USPS or by evidence that came into being after deposit and within one business day of the deposit of the correspondence in the Express Mail drop box (e.g., a copy of a log book indicating that the correspondence was deposited on the date in question). See MPEP 513 and TMEP 702.02(e).

Alternative Procedure Invoking "Extraordinary Circumstances"

If a party can demonstrate that due to extraordinary circumstances the above procedures could not be followed, it

will be necessary to file a petition under 37 CFR 1.183 (patent matter) or 2.146(a)(5) and 2.148 (trademark matter) to waive the requirements of 37 CFR 1.10 to permit the USPTO to accord the correspondence a filing date as of the date that Express Mail deposit was attempted. Such a petition must be accompanied by a statement by the person who originally attempted to deposit the correspondence with the USPS by Express Mail, stating the date that the deposit was attempted and that the USPS refused to accept the correspondence, and be signed by such person subject to the conditions prescribed in 37 CFR 10.18.

Certificates of Mailing Under 37 CFR 1.8

Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

(emphasis added)

A copy of the notice posted on the USPTO Internet site is also included for petitioners' convenience.

In the instant case there is no showing that petitioners ever attempted to deposit the application papers by Express Mail, nor that an attempted deposit of the application papers by Express Mail was refused by the USPS. As such, petitioners have not met the requirements set forth in the above-referenced Official Gazette notice for filing a petition 37 CFR 1.183 to waive the requirement of 37 CFR 1.10. Additionally, the Notice clearly states that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8.

As the showing of record is that petitioners never attempted to deposit the present application papers by Express Mail, but instead simply mailed the application papers by first-class mail with a certificate under 37 CFR 1.8, it is clear that petitioners have not met the requirements for a grantable petition under 37 CFR 1.183 as set forth in the above-referenced Notice.

Furthermore, in reference to Ms. Werner's statement that she was acting in good faith and believed that the USPTO would accord a filing date as of the date of the Certificate of Mailing, to the extent the USPTO might have any discretion in this matter, the circumstances of this application do not demonstrate that justice requires extraordinary relief.

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interest party, subject to such other requirements as may be imposed.³ Petitioner has not shown that either condition exists in this case.

It is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR 1.183.⁴ Waiver of the rules is not warranted when a party makes an avoidable mistake in filing papers.⁵

That is, a lack of knowledge of, or the failure to properly apply, the patent statutes, rules of practice, and procedures before the USPTO is not an adequate basis for requesting extraordinary relief. Specifically, circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief.⁶ Likewise, clerical inadvertence or error is not a ground for requesting waiver of the regulations.⁷

³In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

⁴See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995).

⁵Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1776, 1782 (D.D.C. 1994).

⁶See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

⁷See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994).

It is not understood, and no explanation is given beyond, that counsel's employee Ms. Werner found the Office's instructions "confusing," as why petitioners did not follow the procedure stated in the aforementioned notice. The petition does not state whether petitioners' counsel himself read and understood the Notice. Petitioners apparently cannot recall the USPTO employee to whom Ms. Werner spoke, nor the date upon which the telephone call was made. The showing of record is that petitioners' counsel simply delegated this matter to counsel's employee and did not take adequate steps to ensure that the procedures set forth in the Notification Related to United States Postal Service Interruption were followed in the filing of this application. Failure of counsel to act properly does not constitute an extraordinary circumstance where justice requires waiver of a rule. Rather than extraordinary circumstances, the showing of record is that the procedures set forth in the aforementioned Notice were not followed due to a lack of diligence on the part of petitioners.

In summary, petitioners have not made the showing required to invoke "Extraordinary Circumstances" as set forth in the Official Gazette Notice, *Notification Related to United States Postal Service Interruption*.⁸ Further, rather than extraordinary circumstances, the showing of record is that the procedures set forth in the aforementioned Notice were not followed due to a lack of diligence on the part of petitioners. The petition is therefore dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents
Box DAC
Washington, D.C. 20231

By FAX: (703)308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

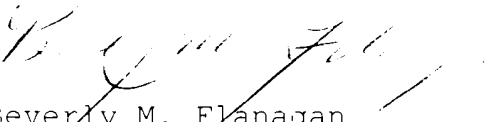
⁸See note 2, *supra*.

The application is being forwarded to Technology Center 1600 for examination in due course with the presently accorded filing date of 10 December, 2001.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood, at (703)308-6918.



Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Encl: Notification Related to United States Postal Service
Interruption--Suspension of the "Express Mail" Service
of United States Postal Service for mail addressed to
ZIP Codes 202xx through 205xx.